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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,376	09/25/2001	Steven M. Ruben	PF524P1	6600

22195 7590 09/22/2003

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT PAPER NUMBER

1646

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/961,376

Applicant(s)

RUBEN ET AL..

Examin r

Prema M Mertz

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1646

-- The MAILING DATE of this communication appears n the cover sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-63 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

I. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group 1. Claims 1-21, are drawn to a nucleic acid molecule encoding a protein of amino acid sequence of set forth in SEQ ID NO:2, a vector, a host cell, and a method for making the protein, classified in Class 435, subclass 69.1.

Group 2. Claim 22, is drawn to a polypeptide of amino acid sequence of set forth in SEQ ID NO:2, classified in Class 530, subclass 350.

Group 3. Claims 23-24 are drawn to an antibody to a polypeptide of amino acid sequence of set forth in SEQ ID NO:2, classified in Class 530, subclass 387.9.

Group 4. Claims 25, 29-30, 35, 37, are drawn to a method of treating an immunodeficiency disease comprising administering the polypeptide of amino acid sequence set forth in SEQ ID NO:2, classified in Class 514, subclass 2.

Group 5. Claims 26, 31, 33, 34, 36, 38, 39, 40-41, 42-63, are drawn to a method of treating an immunodeficiency disease comprising administering an antibody to the polypeptide of amino acid sequence set forth in SEQ ID NO:2, classified in Class 424, subclass 130.1.

Group 6. Claim 27, 30, is drawn to a method of diagnosing an autoimmune disease using a polypeptide of SEQ ID NO:2, classified in Class 435, subclass 7.1.

Group 7. Claim 28, 32, is drawn to a method of diagnosing an autoimmune disease using an antibody to a polypeptide of SEQ ID NO:2, classified in Class 435, subclass 7.1.

Claim 57 is recited as a product claim (see preamble) rather than a method claim since it depends on method claim 39. Therefore, for purposes of this restriction the claim has been

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restricted as a method claim since it appears that applicants intend to claim a method, though based on the claim it reads as a product.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1-2 are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The polynucleotide of invention 1 can be used to make hybridization probes or can be used in gene therapy as well as in the production of the specific proteins of interest. The protein of invention 2 can be used as a probe, or used therapeutically or diagnostically, e.g. in screening. The antibody of invention 3 can be used to obtain the polynucleotide of Group 1, and can also be used in diagnostics, e.g. as a probe in immunoassays.

Inventions 2 and 1 are related as processes of making and products made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case each of the proteins can be prepared by materially different processes, such as by chemical synthesis, or obtained from nature using various isolation and purification protocols.

Inventions 2 and 4, 6 are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P.

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§ 806.05(h)). In the instant case the product of inventions 2 can also be used as an antigen in the production of specific antibodies.

Inventions 3 and 5, 7 are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product of invention 3 can also be used in immunochromatography.

Inventions 1-2, 5, 7 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 1, 3, 4, 6 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 4-7 are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different and recognized divergent subject

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matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

2. Claims 25-32 are generic to a plurality of disclosed patentably distinct species of diseases as recited in claims 25 and 29. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

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Official papers filed by fax should be directed to (703) 305-3014 or (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz
Prema Mertz Ph.D.
Primary Examiner
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August 25, 2003